



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/659,167      | 09/11/2000  | Jeffry Jovan Philyaw | PHLY-25341          | 6274             |

25883 7590 01/18/2005

HOWISON & ARNOTT, L.L.P  
P.O. BOX 741715  
DALLAS, TX 75374-1715

|          |
|----------|
| EXAMINER |
|----------|

PATEL, JAGDISH

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/659,167

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to amendment filed 9/24/04.

***Response to Amendment***

2. Claims 1, 6, 7, and 11 have been amended per request.

***Response to Arguments***

3. Applicant's arguments with respect to the rejection of claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The amended claims recite limitation "...returned personal account information contains routing information relating to vendors...". However, this there is no reference to the routing information in any other and subsequent claims. For example,

Art Unit: 3624

displaying web site information is preformed in response to a hyperlink provided to the user and the user selecting the hyperlink. Thus, it is unclear and indefinite as to the function of having the routing information included in the personal account information.

***Claim Rejections - 35 USC § 103***

4. Claims 1-5, 7-15 and 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US Pat. 6,311,214) (Rhoads) and further in view of PacTel jumps back into electronic directory business with At Hand (Pacific Telesis's Web-based directory of advertising, business listing and advertising), Electronic Marketplace Report, v10, p3(1), July 1996 (hereafter PacTel) and further in view of the official notice.

Per claim 1 Rhoads teaches a method of conducting an e-commerce transaction on a global communication network by using personal account information of a user associated with a credit card retrieved from a credit card company server on the network at a credit card location thereon, comprising the steps of:

at a user location disposed on the network, reading a machine-resolvable code on the credit card of the user with a reading device;

(col. 3 L "Bedoop data" is any form of digital data..data which, initiates some action. Once detected, the system responds in accordance with the detected Bedoop data (e.g., by initiating some local action, or by communication with a remote computer, such as over the internet, via an online service such as AOL, or using point-to-point dial-up communications, as with a bulletin board system, note that the "Bedoop data" is machine resolvable code read at sensor 22 per Fig.1, at the user computer 14 which is connected to a network 18)

Art Unit: 3624

extracted coded information from the MRC (see at least col. 4 L 19-26, ..detects the presence..decoding and col. 5, Para titled Decoding/Encoding);

obtaining routing information associated with the coded information..corresponds to the personal account information of the user stored in the credit card server disposed on the network (col. 7 L 20-36, ..internet server addresses and ..the CLASS and DNS IDs are used in identifying the server computer that will respond to the Bedoop data The UID determines precisely what response should be provided, and col. 22 L24-45);

connecting the user location to the credit card company sever across the network .. (col. 22 L 24+ ..At that address, the holder of the document can review governmental records, such as state or federal tax return data, social security entitlements, etc., as well as privately-maintained records, such as credit records, etc., Bank cards (debit, credit, etc.) can similarly be encoded with Bedoop data to permit the holder to access bank records corresponding to the bank card account.);

returning the personal account information from the credit card company server to the user location (..see the holder of the document can review governmental records, such as state or federal tax return data, social security entitlements, etc., as well as privately-maintained records, such as credit records);

presenting the personal account information to the user .. (see analysis of connecting step as discussed above);

PacTel teaches providing information to the user location, which information contain routing information relating to vendors that previously had been commercially related with the user (see p. 1..as well as one page storefront, where merchant can list more product detail or provide links to jump and home pages).

PacTel further discloses providing a hyperlink to a web site of a vendor in the personal information for automatic connection of the user location .. and displaying web site information of a product of the vendor web site in response to the user selecting the hyperlink.. as per claim 1. (see p. 1 features of web-based directory, ..the impact Ad package

Art Unit: 3624

includes image and banners that are placed within thematic categories on the service..).

Alternatively,

However, official is taken that providing advertisements for products and services of a vendor and hyperlinks of the vendor product to purchase the advertised products and displaying web site information of a product of the vendor in response to selection of the hyperlink of the advertised product by a user is old and well known practice in the field of promotions and advertisements. It is also noted that including advertisement material (inserts) for products and services in the monthly billing statements of credit cards is old and well-known practice. The billing entity in the later case provides all necessary product details and product vendor's web address (or traditional mail address) such that the user is able to select and purchase one or more products.

In view of the aforementioned officially noted fact, and alternatively in view of Pactel, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a hyperlink to a web site of a vendor in the personal information presented to the user and display web site information of a product of the vendor in response to the user selecting the hyperlink because this combination would facilitate the credit card issuer to electronically advertise and market (offer for sale) product of its own or other vendors' products who arrange to have their products marketed to the customers of the credit card company.

It would also have been obvious to one of ordinary skill in the art at the time of the invention to modify Rhoads so as to incorporate routing information relating to vendors that previously had been commercially related with the user because such routing information would enable the user to quickly and conveniently connect to the vendors for further communication related to commercial activity.

Claims 2 and 3: MRC is optical data (a bar core code) see col. 3+ ..Bedoop data is any form of digital data encoding recognized by the system 10--data which, in many embodiments, initiates some action..).

Art Unit: 3624

Claim 4: the routing information is stored on a user computer at the user location..;

(col. 4 19-26, ..the database. Col. 7 L 30-36, ..identifying the server computer)

Claim 5: refer to analysis of claims 1 and 4.

Claim 7: ..displayed on a computer display ..connected to the user computer (col. 27 L 43-51).

Claims 8 -10: refer to analysis of claim 1.

5. Claim 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US Pat. 6,311,214) (Rhoads) and further in view of PacTel and official notice and further in view of Reynolds et al. (6,149,063)

Claim 6: Rhoads and Pactel fails to disclose that the reading device is a wireless scanner per claim 6. However, Reynolds (6,149,063) discloses a bar code symbol which includes encoded information pertaining to the base station. A wireless bar code scanner is adapted to scan and decode the network ID label. The wireless bar code scanner initiates a communications link with the base station utilizing information from the decoded network ID label. In view of the aforementioned officially noted fact, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the wireless scanner of Reynolds as the reading device because it would provide a convenient and economical method for associating a wireless device to the user location without requiring a physical interface between the wireless device and the network.

6. Claims 11-15 and 17-20 have been interpreted as system claims that would facilitate practicing of corresponding method claims 1-10 methods. Therefore claims 11-20 have been analyzed as rejected per analysis of claims 1-10 respectively.

### **Conclusion**

Art Unit: 3624

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

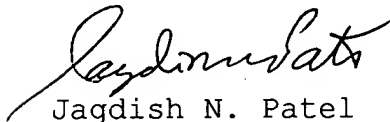
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the



Art Unit: 3624

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

1/5/05